

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY M. QUANDT

Appeal No. 1999-2364
Application No. 08/562,816¹

ON BRIEF

Before CALVERT, MCQUADE, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection² of claims 1 to 19 and 21, all the claims remaining in the application.

¹ Application for patent filed November 27, 1995.

² Paper No. 14, April 3, 1998.

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The appealed claims are drawn to a bed liner in combination with a mattress, box spring, bed board, cot or hammock (claims 1 to 10), or to a bed liner per se (claims 11 to 19 and 21), and are reproduced in the new appendix submitted by appellant on September 22, 1999 (Paper No. 23).³

The references applied in the final rejection are:

North 1950	2,525,713	Oct. 10,
Chapuis 1970	3,541,620	Nov. 24,
Young 1974	3,842,454	Oct. 22,
Schuetze 1983	4,413,368	Nov. 8,
Hoss et al. (Hoss) 1990	4,924,543	May 15,

Gershman, Self-Adhering Nylon Tapes, 168 A.M.A. Journal No.7
(Oct. 18, 1958) (Gershman)

Claims 1 to 19 and 21 stand finally rejected on the following grounds:

(1) Claims 1, 5 and 7, anticipated by North, under 35 U.S.C. § 102(b);

(2) Claims 2, 3, 10, 18 and 19, unpatentable over North in view of Schuetze and Hoss, under 35 U.S.C. § 103(a);

³ In claim 5, line 4, we note that there should be a comma before "from," and "the" should be --said--.

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(3) Claim 4, unpatentable over North in view of Schuetze, Hoss and Gershman, under 35 U.S.C. § 103(a);

(4) Claims 6, 9, 13 to 15 and 17, unpatentable over North in view of Young, under 35 U.S.C. § 103(a);

(5) Claims 8 and 12, unpatentable over North in view of Gershman, under 35 U.S.C. § 103(a);

(6) Claim 16, unpatentable over North in view of Young, Schuetze, Hoss and Gershman, under 35 U.S.C. § 103(a);

(7) Claim 21, unpatentable over North in view of Schuetze, Hoss and Young, under 35 U.S.C. § 103(a).

(8) Claims 11 and 12, unpatentable over Chapuis, under 35 U.S.C. § 103(a).

Rejection (1)

In order to anticipate claim 1, North must disclose every limitation of that claim, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Appellant first argues that the width of North's bottom sheet 1 is not "at least about 50% greater" than the width of top sheet 2, as claimed. North does not disclose any specific dimensions, but from measuring the sheets shown in Fig. 3, appellant calculates that the bottom sheet is 41%

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wider than the top sheet (reply brief, p. 3). The examiner contends that this is "about 50%."

It is unnecessary to decide this issue, because we agree with appellant's further argument that North does not disclose a releasable connection between the top and bottom sheets which, as recited in claim 1, "extend[s] from said top edge of said top sheet toward said bottom edge thereof." In North, the only disclosed releasable connection between the top and bottom sheets is in the form of ribbons 15 and 16. These ribbons do not extend from the top edge of the top sheet 2, as required by claim 1, but

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rather are located part of the way down the side of the top sheet at fold line 13, leaving the upper end 14 of the top sheet free to be folded back at line 13.

Although not argued by appellant, we note that North also does not meet the requirement of claim 1 that there be "a first connection between said top and bottom sheets along substantially the entire length of said first side edge of said top sheet," because the connection (seam 3) between North's top and bottom sheets is not along "substantially the entire length" of a side edge of top sheet 2.

We therefore will not sustain rejection (1) of claim 1, nor, it follows, of dependent claims 5 and 7.

Rejection (2)

With regard to claims 2, 3 and 10, the Schuetze and Hoss references do not render obvious the above-noted differences between parent claim 1 and North's disclosure. Rejection (2) therefore will not be sustained as to those claims.

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Rejection (2) also will not be sustained as to claim 18, and claim 19 dependent thereon, because neither North, Schuetze nor Hoss teaches or suggests the use of "a plurality of spaced, in line snap fasteners" as recited in claim 18.

Rejection (3)

Since the secondary references applied in this rejection do not render obvious the differences between parent claim 1 and the disclosure of North noted in the discussion of rejection (1), supra, rejection (3) will not be sustained.

Rejection (4)

This rejection will not be sustained as to claims 6 and 9, for the same reason as stated in the foregoing paragraph concerning rejection (3).

Independent claim 13 recites, inter alia, that portions of the bottom sheet top face and top sheet bottom face "comprise sweatshirt fleece." The examiner states the basis of this rejection on page 5 of the final rejection as:

North fails to disclose the top sheet having a bottom face comprised of fleece. Young discloses a top sheet 12 having a bottom face comprised of a soft plush fabric such as wool or cotton (col. 3 lines 19-24). It would have been obvious to place the fabric surface as taught by Young

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on the bottom face of the top sheet of
North in order to provide a comfortable
contact surface that is easily

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cleaned. The fabric taught by Young is considered an equivalent to the applicant's "sweatshirt fleece" since it is well known that fleece is defined as either a fabric such as a coat of wool or a fabric with a soft deep pile.

In considering this rejection, we do not find in Young (which discloses a sleeping bag for dogs and other domestic animals) any disclosure of a "soft plush fabric," the examiner's statement to the contrary notwithstanding. Col. 3, lines 19 to 24 of Young, to which the examiner refers, reads:

The fabric used for the upper and lower covers should be selected for ease in cleaning or washing and resistant [sic] to stain. Other than meeting those requirements, any fabric including cotton, wool, synthetic or canvas and the like may be utilized.

According to the examiner, supra, the fabric disclosed by Young is an equivalent of sweatshirt fleece, but it is not clear how the examiner arrives at this conclusion, or why, even if correct, it would have been obvious to employ sweatshirt fleece as or on North's sheets. There being no disclosure in the applied references of sweatshirt fleece or its use for such a purpose, the rejection of claims 13 to 15 and 17 will not be sustained.

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Rejection (5)

This rejection will not be sustained as to claim 8 for the same reason as stated in the previous paragraph concerning rejection (3).

As for claim 12⁴, parent claim 11 requires, inter alia, that the top sheet have a width and length substantially the same as the bottom sheet, and be connected to the bottom sheet adjacent the bottom edge of the top sheet. In North, on the other hand, the bottom sheet 1 is wider than the top sheet 2, and the bottom edge of top sheet 2 is not connected to bottom sheet 1. Thus, contrary to the examiner's statement on page 4 of the final rejection, North does not disclose "all of the appellant's claimed limitations except for the second releasable connection comprising a zipper."

Since there is no teaching or suggestion in Gershman which would have motivated one of ordinary skill to modify the North bed liner to meet the above-noted differences between North and parent claim 11, rejection (5) of claim 12 will not be sustained.

⁴ Since claim 12 depends from claim 11, it is not clear why claim 11 was not included in this rejection.

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Rejection (6)

This rejection will not be sustained, since Gershman does not supply the deficiency noted in the rejection of claim 13, supra (under rejection (4)).

Rejection (7)

This rejection will likewise not be sustained inasmuch as the rejection of parent claim 18 will not be sustained (under rejection (2), supra), and Young does not supply the deficiency noted as to that rejection.

Rejection (8)

Of particular interest in this rejection is the arrangement shown in Fig. 2 of Chapuis, where a sleeping bag has been formed by folding the fabric of Fig.1, with layer 4 on the outside (col. 2, lines 42 and 46); thus, there is a fold down the right hand edge of the bag, producing a top fabric sheet and a bottom fabric sheet of the same width and length, connected at the right side edge. While not described in the specification, Chapuis appears to show in Fig. 2, as appellant states on page 8 of the brief, "a zipper extending along the bottom, [left] side, and top thereof." Since the zipper is shown as closed along the bottom of the bag,

(most of) the left side of the bag, and open at the top of the bag, Chapuis' Fig. 2 meets the recitations of claim 11 that the top sheet and bottom sheet are connected at their bottom and side edges and unconnected at their top edges.

Claim 11 recites that the bottom sheet has "a width of about 50-75 inches, [and] a length of about 80-90 inches." Chapuis does not disclose any dimensions, but the examiner asserts that "[a] change in size is generally recognized as being within the level of ordinary skill in the art," citing In re Rose, 220 F.2d 459, 463, 105 USPQ 237, 240 (CCPA 1955)⁵ (answer, p.7).

Appellant contends on page 9 of the brief that "There is absolutely no reason why one of ordinary skill in the art would provide the dimensions set forth in claim 11 in Chapuis [sic]." We disagree. The sleeping bag shown in Fig. 2 of Chapuis would obviously have to be of sufficient height and width to comfortably accommodate the user. If the user were taller than six feet, for example, in our view the bag would

⁵ In re Rose states that the size of an article "is not ordinarily a matter of invention" (220 F.2d at 463, 105 USPQ at 240).

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be made sufficiently long to accommodate the user's height,
which would take it into the claimed 80 to 90 inch range.
Similarly, the top

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and bottom sheets would have to be wide enough to allow a user to lie between them, and, particularly in order to encompass large sized persons, it would have been obvious to make a bag having a width of at least about 50 inches.

For the foregoing reasons we conclude that claim 11 is unpatentable over Chapuis under § 103.

On the other hand, we find nothing in Chapuis which would suggest to one of ordinary skill that the Fig. 2 sleeping bag be provided with a "zippered generally central access seam . . . extending less than 50% the length of said bottom sheet," as required by claim 12. We will accordingly sustain the rejection of claim 11, but not of claim 12.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR 1.196(b), claims 1 to 10, 13 to 19 and 21 are rejected for failing to comply with 35 U.S.C. § 112, second paragraph, for the following reasons.⁶

⁶ Under the circumstances of this case, our conclusion that claims 1 to 10, 13 to 19 and 21 do not comply with § 112, second paragraph, does not preclude our consideration on the merits of the rejections of those claims as unpatentable over prior art. Cf. Ex parte Saceman, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993).

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(A) Claim 1, line 5, "said bottom fabric" has no antecedent basis. Also, in lines 5 and 6, it appears that something has been omitted from the phrase "said bottom fabric . . . hammock," which is incomplete as it stands.

(B) Claim 13, line 5, the expression "a third width" is unclear, because no second width is recited. Also, "said bottom sheet top face first portion" in line 10 has no antecedent basis.

(C) Claim 18, line 10, "said bottom sheet" (two occurrences) has no antecedent basis.

Conclusion

The examiner's decision to reject claims 1 to 19 and 21 is reversed as to all of said claims except claim 11, as to which it is affirmed. Claims 1 to 10, 13 to 19 and 21 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that

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"[a] new ground of rejection shall not be considered final for purposes of judicial review."

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Regarding any affirmed rejection, 37 CFR § 1.197(b)
provides:

(b) Appellant may file a single request for
rehearing within two months from the date of the
original decision. . . .

37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings (37
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims
so rejected or a showing of facts relating to the
claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

Should the appellant elect to prosecute further before
the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in
order to preserve the right to seek review under 35 U.S.C. §§
141 or 145 with respect to the affirmed rejection, the
effective date of the affirmance is deferred until conclusion
of the prosecution before the examiner unless, as a mere

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incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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AFFIRMED-IN-PART; 196(B)

Prepared: August 8, 2000